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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,310	08/24/2001	Nao Fujita	011059	1067

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ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON, DC 20006

EXAMINER

WILSON, DONALD R

ART UNIT PAPER NUMBER

1713

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/938,310

Applicant(s)

FUJITA ET AL.

Examiner

Donald R Wilson

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1713

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 08 January 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-3, 15-24 and 35.

Claim(s) withdrawn from consideration: 4-6 and 25-34.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Donald R Wilson
Primary Examiner
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ADDITIONAL COMMENTS

Response to Proposed Amendment After Final

1. Applicant's proposed amendment and declaration filed 1/8/04, after final rejection, has been fully considered with the following results.

2. The proposed amendment if entered, limiting the scope of oxidizing agents to those that result in the production of a purified polymer is not seen to overcome the rejection. Applicant is attempting to define the invention in terms of whatever works as opposed to setting forth,

“--- the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains” (35 U.S.C. § 112, first paragraph),

as is required for the written description and enablement for the scope of what is being claimed. The argument that only routine experimentation, not undue experimentation, would be required to determine what particular oxidizing agents result in purified polymer, is also not deemed to be persuasive. Applicant does not rebut that many of the agents set forth in the specification as suitable oxidizing agents are known to cause reactions of vinyl group containing polymers including polymerization, cross-linking, grafting, double bond addition, formation of ozonides etc. Thus, there is no effective guidance of acceptable oxidizing agents other than those used in the examples. Testing involves more than just determining whether or not the catalyst has been removed, but whether the improvement in hydrosilylation activity results, and whether or not the catalyst has caused other deleterious changes to the polymer. While the skilled artisan is capable of performing such research, the amount of experimentation is still seen to be undue.

3. Applicant's traversal of the rejection of claims over Roos in view of Nakagawa has been carefully considered but is not found to be persuasive. Applicant is correct in stating that there must be some motivation to combine the references, which the Examiner has provided,

“It would have been obvious to one of ordinary skill in the art to employ the purification procedure disclosed by Roos to other ATRP polymers such as taught by Nakagawa in order to overcome the discoloration problems known to exist with ATRP polymers containing catalyst residues.”

As earlier pointed out polymers made using ATRP methods are known to discolor if the transition metal catalysts are not removed. However, applicant is incorrect in stating that the motivation must come from the references themselves. See *In re Preda* and *In re Rouffet* cited in the previous Office Action.

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4. The argument that the combination of references is improper because they are concerned with different problems is also not deemed to be persuasive. The determination that a reference is from a nonanalogous art is twofold. First, it is decided if the reference is within the field of the inventor's endeavor. If it is not, then it must be determined whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174; *In re Clay*, 23 USPQ.2d 1058. In the instant situation, both references are concerned with methods using ATRP methods of polymerization, which is at least in the field of the inventor's endeavor. The argument that Nakagawa teaches that the polymer can be molded into a uniform cured sheet having good physical properties does not negate that discoloration of the polymer due to the presence of catalyst residues could be overcome by purifying the polymer according to the method taught by Roos.

5. The arguments that Roos doesn't teach polymers may be used as a component for a hydrosilylatable composition is not deemed to be persuasive because the intended use does not impart patentability to the instantly claimed process.

Intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963) (The claims were directed to a core member for hair curlers and a process of making a core member for hair curlers. Court held that the intended use of hair curling was of no significance to the structure and process of making.) See M.P.E.P. § 2111.03.

The argument that neither reference teaches improved hydrosilylation activity, and the declaration demonstrating such, are not deemed to be persuasive because a *prima facie* case of obviousness (for a composition) does not require the solution of the same problem or recognition of the same advantages as the applicants invention. *In re Dillon* 16 USPQ2nd 1897 (CAFC, en banc, 1990), which overrules *In re Dillon* 13 USPQ 2nd 1337 and *In re Wright* 6 USPQ 2nd 1959. Further, "[t]he fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be

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the basis for patentability when the differences would otherwise be obvious." *Ex parte*

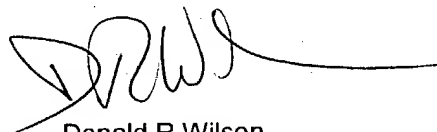
Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R Wilson whose telephone number is 571-272-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications. The unofficial direct fax phone number to the Examiner's desk is 571-273-1113.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

A handwritten signature in black ink, appearing to read 'DRW', with a long horizontal line extending to the right.

Donald R Wilson
Primary Examiner
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